

**REMARKS**

Reconsideration and allowance of the subject patent application are respectfully requested.

Claim 22 was rejected under 35 U.S.C. Section 101 as allegedly being directed to non-statutory subject matter. Claim 22 has been amended to recite “[a] program stored on a computer-readable storage medium for implementing …” and withdrawal of the rejection is respectfully requested.

Claims 2-9 and 11-23 were provisionally rejected under the non-statutory doctrine of obviousness-type double patenting as allegedly being unpatentable over the claims of application no. 11/652,472. This rejection is provisional because the referenced claims of application no. 11/652,472 are not yet patented. Applicants do not agree with this rejection. Nonetheless, if the ‘472 application claims are patented prior to the granting of this application and if otherwise appropriate, Applicants will take steps to address this rejection.

Claims 18 and 19 were rejected under 35 U.S.C. Section 102(e) as allegedly being “anticipated” by Lee et al. (U.S. Patent Application Publication No. 2002/0013143).

Claim 18 is directed to a broadcast recording system comprising a recording server and an information terminal device. The recording server records broadcast information being received by the information terminal device when a “failure of receiving” is detected during receiving of the broadcast information by the information terminal device. The office action contends that Lee et al. anticipates this system.

Lee et al. describes a system in which a user connects to a data supplying server 300 using a personal computer 100 in order to select a file for downloading to a mobile phone 600 by specifying its telephone number. Data supplying server 300 then attempts to connect to the mobile phone 600 over the mobile communication network 400. Paragraph [0038] of Lee et al. describes that if the connection is not made within some

predetermined period of time, the data supplying server 300 can connect to a data storing space 500 for downloading the data.

Claim 18 recites certain operations between a recording server and an information terminal device “when a failure of receiving is detected during receiving of the broadcast information by the information terminal device.” As noted above, paragraph [0038] of Lee et al. recites certain operations when a connection to the mobile phone 600 is not made at all. Consequently, Lee et al. does not describe what happens when the mobile phone 600 experiences a failure of receiving during the receiving. Lee et al. therefore cannot anticipate claim 18 or its dependent claim 19.

Moreover, claim 19 recites that the recording server stops recording when there is a recovery of the receiving of the broadcast information. Lee et al. provides no description whatsoever of this feature.

Claims 1, 4, 10, 22, 23, 51, 54 and 59 were rejected under 35 U.S.C. Section 103(a) as allegedly being made “obvious” by Engstrom (U.S. Patent No. 7,065,333) in view of Lord (U.S. Patent No. 7,054,660). While not acquiescing in this rejection or in the characterization of the applied references with respect to the features of claims 51, 54 and 59, these claims have been canceled without prejudice or disclaimer and thus the rejection of these claims is moot.

Engstrom discloses a mobile device that includes multiple tuners so that, for example, when a tuner is tuned to a broadcast that is currently playing, another tuner is used to scan for another broadcast based on user preference. When the other broadcast based on user preference is located, the user can selectively play the currently playing broadcast or the other broadcast. See Engstrom, col. 1, lines 57-62. When the mobile device is selected for another purpose, the currently playing broadcast is interrupted and recorded from a point where the interruption occurred. When the other purpose is finished, the recording of the currently playing broadcast is played from the point of interruption. "Other purposes" include making or receiving a telephone call. See

Engstrom, col. 1, line 63 to col. 2, line 4; col. 10, line 12 to col. 11, line 3; Figures 7 and 8.

The office action concedes that Engstrom does not teach inquiring whether a broadcast signal should be recorded or not when an incoming or outgoing call is detected as recited in claim 1. Reference is made to col. 11, lines 33-36 of Lord as allegedly providing this feature. However, this portion of Lord simply describes software that is operative to record a broadcast if that broadcast contains requested data. There is no concept here of inquiring whether to record when a call (incoming or outgoing) is detected. Claim 1 provides an option to record when a call is detected. In contrast, Lord describes that recording takes place when a broadcast contains requested data. Consequently, even were Engstrom and Lord combined, the subject matter of claim 1 and its dependent claims 4, 22 and 23 would not result.

Claim 10 describes an interface configured to inquire whether a currently received broadcast signal should be recorded or not. As noted above, Lord does not remedy the admitted deficiencies of Engstrom in this regard and consequently claim 10 is not made obvious by the proposed combination of these references.

Claims 2, 3, 52 and 53 were rejected under 35 U.S.C. Section 103(a) as allegedly being made “obvious” by the proposed Engstrom-Lord combination, further in view of Cahill (U.S. Patent No. 5,150,384). While not acquiescing in this rejection or in the characterization of the applied references with respect to the features of claims 52 and 53, these claims have been canceled without prejudice or disclaimer and thus the rejection of these claims is moot.

Claims 2 and 3 depend from claim 1. First, Cahill does not remedy the deficiencies of Engstrom and Lord with respect to claim 1. Second, Cahill deals with fading conditions of a carrier signal and provides no teaching with respect to recording/playback operations when a broadcast signal is recovered.

Claims 5, 7 and 55 were rejected under 35 U.S.C. Section 103(a) as allegedly being made “obvious” by the proposed Engstrom-Lord combination, further in view of

Norita (JP 11136202). While not acquiescing in this rejection or in the characterization of the applied references with respect to the features of claim 55, this claim has been canceled without prejudice or disclaimer and thus the rejection of this claim is moot.

Claims 5 and 7 depend from claim 1. First, Norita does not remedy the deficiencies of Engstrom and Lord with respect to claim 1. Second, the very brief English-language abstract of Norita does not disclose the concept of an external recording device as claimed.

Claim 6 was rejected under 35 U.S.C. Section 103(a) as allegedly being made “obvious” by Engstrom in view of Cahill.

Engstrom is acknowledged in the office action to be deficient with respect to what happens when there is a failure to receive a broadcast. As noted above, Cahill deals with fading conditions of a carrier signal and provides no teaching with respect to recording operations when a broadcast signal is recovered. Consequently, the proposed combination of these references would not have resulted in a method in which recording takes place when an incoming or outgoing call is detected or when a failure to receive a broadcast signal is detected as recited in claim 6.

Claims 8, 9, 12-16, 57 and 58 were rejected under 35 U.S.C. Section 103(a) as allegedly being made “obvious” by Engstrom in view of Lee et al. While not acquiescing in this rejection or in the characterization of the applied references with respect to the features of claims 15 and 16, these claims have been canceled without prejudice or disclaimer and thus the rejection of these claims is moot.

The deficiencies of Enstrom and Lee et al. with respect to rejected independent claims 8, 12 and 57 is most easily seen by noting that these claims involve the terminal device (receiving-side) detecting that a broadcast signal cannot be received.

Lee et al. is cited as remedying the deficiencies of Engstrom. However, in Lee et al., the data supplying server 300 (transmitter-side) detects when a mobile phone cannot be contacted. The cited references, taken either alone or in combination, do not disclose or suggest a terminal device that generates a recording signal for an external device in

response to a detection that a broadcast signal cannot be received. Specifically, Engstrom does not disclose an external recording device and, to the extent the data storing device 500 of Lee et al. is argued to constitute a recording device, the server, not the mobile phone, initiates any “recording process” in this recording device.

The dependent claims 9, 13, 14 and 58 recite additional features not shown in the applied references.

Claims 11, 47, 50, 56 and 60 were rejected under 35 U.S.C. Section 103(a) as allegedly being made “obvious” by the proposed Engstrom-Lord combination, further in view of Lee et al. While not acquiescing in this rejection or in the characterization of the applied references with respect to the features of claims 50, 56 and 60, these claims have been canceled without prejudice or disclaimer and thus the rejection of these claims is moot.

Claim 11 depends from claim 10. Among other things, Lee et al. does not remedy the deficiencies of Engstrom and Lord with respect to claim 10, from which claim 11 depends.

Claim 47 is presented in self-standing independent form. Engstrom, Lord and Lee et al., taken either individually or in combination, do not disclose or suggest recording a broadcast signal in a recording device installed in an external recording server when it is impossible to record the broadcast signal in a recording device installed in a terminal device.

Claims 20 and 21 were rejected under 35 U.S.C. Section 103(a) as allegedly being made “obvious” by Lee et al. in view of Engstrom.

Among other things, Engstrom does not remedy the deficiencies of Lee et al. with respect to claim 18, from which claims 20 and 21 depend. Consequently, claims 20 and 21 patentably distinguish from these references.

Claims 48 and 49 were rejected under 35 U.S.C. Section 103(a) as allegedly being made “obvious” by the proposed Engstrom-Lord-Cahill combination, further in view of Lee et al. While not acquiescing in this rejection or in the characterization of the applied

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references with respect to the features of these claims, claims 48 and 49 have been canceled without prejudice or disclaimer and thus this rejection is moot.

New claim 61 is added. The subject matter of this claim is fully supported by the original disclosure and no new matter is added. The Examiner is invited to independently confirm that this is the case.

Claim 61 recites a terminal device that transmits a command signal to record currently recording broadcast signals on an external recording server when a detector detects that the broadcast signals cannot be recorded in a recording device installed in the terminal device. No such feature is shown in the applied references.

The pending claims are believed to be allowable and favorable office action is respectfully requested.

Respectfully submitted,

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